

Notice of Allowability

Application No.

10/713,174

Applicant(s)

BENSON ET AL.

Examiner

Art Unit

Robert Shiao, Ph. D.

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to responses filed on 04/12/2006.
2. ☒ The allowed claim(s) is/are 1-12 and 36-41, now are 1-18.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: ____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date ____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date ____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>1/23/2006</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other ____. |

DETAILED ACTION

1. Amendment of claims 1, and 3-6, cancellation of claims 13-35, and addition of claims 36-42 in the amendment filed on April 12, 2006, is acknowledged. Claims 1-12 and 36-42 are pending in the application. No new matter is found. Since the newly added claims 36-42 are commensurate with the scope of the invention, therefore, claims 1-12 and 36-42 are prosecuted in the case.

Responses to Amendment

2. Since the variable Y^1 of formula (I) does not represents a single bond, and the the variable Y^1 of formula (I) represents a divalent group comprising at least one heteroalkylene having an oxy group or a $-NR^d$ group, therefore, the rejection of claims 1-12 under 35 U.S.C. 102(a), 102(b), or 103(a) has been overcome in the amendment filed on April 12, 2006.

3. Since the variable X^1 of formula (I) does not represents an ethylically unsaturated group, therefore, the provisional rejection of claims 1-12 under obviousness-type double patenting over Benson et al. co-pending application No. 10/987,522, has been overcome in the amendment filed on April 12, 2006.

EXAMINER'S AMENDMENT

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an

amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Jean A. Lown on May 12, 2006. The application has been amended as follows:

In claim 1, line 18, delete "can be fused to an optional benzene ring", and insert --is selected from an optional saturated or unsaturated benzoisothiazole or benzothiazole thereof--

In claim 41, line 2, after "heterocyclic group", insert --, wherein the heterocyclic group is selected from an optional saturated or unsaturated benzoisothiazole or benzothiazole thereof--

Delete claim 42.

Reasons for Allowance

5. The following is an examiner's statement of reasons for allowance:

Claims 1-12 and 36-41 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to N-sulfonylaminocarbonyl containing compounds. The closest reference is Salzburg et al. US 4,713,389, which discloses functional and bactericidally active acylated saccharin derivatives. The difference between instant claims and Salzburg et al. is that the instant compounds of formula (I) were not disclosed by Salzburg et al. A suggestion for

modification of the above reference to obtain the instant compounds/compositions has not been found. Claims 1-12 and 36-41 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1626

R.S.
Robert Shiao, Ph.D.
Patent Examiner
Art Unit 1626

May 16, 2006

Joseph K. McKane
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